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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,091	06/20/2005	Wenping Wu	10377.204-US	7525

25908 7590 10/25/2006

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NEW YORK, NY 10110

EXAMINER
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CHOWDHURY, IQBAL HOSSAIN

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/540,091	Applicant(s) WU ET AL.	
	Examiner Iqbal H. Chowdhury, Ph.D.	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 23-34 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

This application is a 371 of PCT/DK03/00914.

The preliminary amendment filed June 20, 2005 canceling claims 1-22 and newly added claims 23-34 has been entered.

Claims 23-34 are pending.

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group, I claim(s) 23-24 and 32, drawn to an isolated polypeptide having cellobiohydrolases II activity.

Group, II claim(s) 25-31, drawn to an isolated polynucleotide encoding a polypeptide having cellobiohydrolases II activity, vector, host cell, a method of producing polypeptide and probe.

Group, III claim(s) 33, a transgenic plant, plant part or plant cells transformed with said polynucleotide encoding polypeptide-having cellobiohydrolases II activity.

Group, IV claim(s) 34, drawn to a detergent composition comprising surfactant and said polypeptide.

Art Unit: 1652

For each inventions I-IV above, restriction to one of the following is also required under 35 U.S.C. 121 and 372. Therefore, election is required of one of inventions I-IV and one of inventions (A) – (N).

- (A). protein of SEQ ID NO: 2 or a nucleic acid encoding SEQ ID NO: 2.
- (B). protein of SEQ ID NO: 4 or a nucleic acid encoding SEQ ID NO: 4.
- (C). protein of SEQ ID NO: 6 or a nucleic acid encoding SEQ ID NO: 6.
- (D). protein of SEQ ID NO: 8 or a nucleic acid encoding SEQ ID NO: 8.
- (E). protein of SEQ ID NO: 10 or a nucleic acid encoding SEQ ID NO: 10.
- (F). protein of SEQ ID NO: 12 or a nucleic acid encoding SEQ ID NO: 12.
- (G). protein of SEQ ID NO: 14 or a nucleic acid encoding SEQ ID NO: 14.
- (H). protein of SEQ ID NO: 16 or a nucleic acid encoding SEQ ID NO: 16.
- (I). protein of SEQ ID NO: 18 or a nucleic acid encoding SEQ ID NO: 18.
- (J). protein of SEQ ID NO: 20 or a nucleic acid encoding SEQ ID NO: 20.
- (K). protein of SEQ ID NO: 22 or a nucleic acid encoding SEQ ID NO: 22.
- (L). protein of SEQ ID NO: 24 or a nucleic acid encoding SEQ ID NO: 24.
- (M). protein of SEQ ID NO: 26 or a nucleic acid encoding SEQ ID NO: 26.
- (N). protein of SEQ ID NO: 4 or a nucleic acid encoding SEQ ID NO: 4.

2. The inventions listed as Groups I - IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The polynucleotide encoding a polypeptide having cellobiohydrolases II activity of Group II, polypeptide having cellobiohydrolases II activity of

Art Unit: 1652

Group I, transgenic plant of Group III and detergent of Group IV are each unrelated and chemically distinct entities. The only shared technical feature of these groups is that they all relate to polynucleotide encoding a polypeptide having cellobiohydrolases II activity. However, this shared technical feature is not a "special technical feature" as defined by PCT Rule 13.2 as it does not define a contribution over the art. According to the search report (PCT form 210), a DNA encoding a polypeptide having cellobiohydrolases II activity is known in the art (GenBank Accession No. AAA34210 and M16190<sup>see IDS</sup>). Thus, a DNA encoding a polypeptide having cellobiohydrolases II activity does not make contribution over the prior art.

3. The transgenic plant of Group III does not share any "special technical feature" with Group I as the polypeptide of Group I is neither made nor used by the transgenic plant of Group III.

4. The detergent composition of Group IV does not share any "special technical feature" with Group II as the polynucleotides of Group II are neither made nor used by the a detergent composition of groups IV.

5. The nucleic acid and proteins of Group (A)-(N) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different nucleotides encoding proteins of Group (A)-(N), which are polypeptides having cellobiohydrolases II activity, do not have special technical feature among each other because they all represent structurally different polypeptides and polynucleotide encoding them. As mentioned above, a DNA encoding a polypeptide having cellobiohydrolases

Art Unit: 1652

II activity is known in the art and does not make contribution over the prior art. Therefore, they all lack special technical feature.

A telephone call was made to Jason Garbell on 10/19/2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

37 CFR 1.475 does not provide for multiple products and/or methods within a single application. Therefore, inventions of Group I - IV lack unity of invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102,

Art Unit: 1652


103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iqbal Chowdhury whose telephone number is 571-272-8137. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,

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